

1 REMARKS

2 Claims 1-33 remain pending in the present application. Applicants have amended  
3 Claims 1, 18, and 24 to more clearly define the present invention.

4 Claims Rejected under 35 U.S.C. § 103(a) Over Sobol and Hawes

5 Claims 1-6, 9-10, 16, 18, 21, 23, 24, 27, 29, 30, 32, and 33 have been rejected under  
6 35 U.S.C. § 103(a) as being unpatentable over Sobol et al. (U.S. Patent No. 5,907,665, hereinafter  
7 Sobol) in view of Hawes (U.S. Patent No. 6,094,662 B1, hereinafter Hawes). Applicants respectfully  
8 disagree that the cited prior art renders any of the claims obvious. However, in the interest of  
9 reducing the complexity of the issues for the Examiner to consider in this response, the following  
10 discussion focuses on independent Claims 1, 18, and 24, and the patentability of every dependent  
11 claim is not necessarily separately addressed in this response. Applicants' decision not to discuss the  
12 differences between the cited art and each dependent claim in the present application should not be  
13 considered as an admission that applicants concur with the Examiner that the dependent claims are  
14 not patentable over the disclosure in the cited references. Instead, applicants believe that the  
15 dependent claims also patentably distinguish over the references cited. As will be clear from the  
16 following remarks, the independent claims in the present application recite an invention that is  
17 patentable. Because the dependent claims inherently include all of the elements of the independent  
18 claim from which they ultimately depend, all of the dependent claims are patentable for at least the  
19 same reasons as the independent claims.

20 As to independent Claim 1, the Examiner refers to the background section of Sobol when  
21 asserting that "Sobol discloses the acquisition, and insertion of a scanned image, with the aid of an  
22 active scanner, into a document(s)" (Office Action, page 2, section 4). Specifically, Sobol states that  
23 "While application programs exist that will allow user to import a binary image data file of scanned  
24 line art image into [ ] a document, the scanned image reproduced thereby is often of inferior quality"  
25 (Sobol, col. 2, lines 6-10). Sobol attempts to address the inferior quality of scanned grayscale image  
26 data, such as stair-step "jaggies," by changing light gray pixels to white pixels, changing dark gray  
27 pixels to black pixels, compressing the changed image data, and scaling or otherwise transforming  
28 the compressed image data for use in a document.

29 The Examiner admits that "Sobol fails to explicitly disclose: *inserting data*  
30 *representing said image . . . all without saving said data in other than a temporary buffer*" (italics  
31 in original, Office Action, page 2, section 4). Instead, the Examiner refers to a portion of Hawes as  
32 teaching the insertion of an image, and storage of the image in a cache or temporary buffer. The  
33 Examiner concludes that "It would have been obvious to a person of ordinary skill in the art at the  
34 time of the invention to have combined the teachings of Sobol and Hawes, because Hawes teaches  
35 above the efficient storage of images" (Office Action, page 3). Even if Hawes teaches an efficient

1 method for storing images, Hawes does not disclose or suggest inserting image data without saving  
2 the data, as claimed by applicants. Hawes is directed to marking portions of a Web page as  
3 cacheable. Specifically, "The browser 180 separates the web page 212 into cacheable portions to  
4 be stored in the cache portion 184 of the memory 172 and non-cacheable portions to be stored in  
5 other, non-cache, portions of the memory 172" (Hawes, col. 4, lines 50-53). Hawes explains that  
6 "in the general case, the non-HTML portions, such as GIFs, or bitmaps or other image portions are  
7 stored as cacheable information" (Hawes, col. 5, lines 9-11). Thus, images are cacheable  
8 information of a Web page, and the images are stored in the cache portion of memory. The benefit  
9 of Hawes is that "the page can be reloaded without transferring large graphics images if those  
10 graphics images have not changed from the graphics images stored in the browser's cache"  
11 (Hawes, col. 2, lines 61-64). However, Hawes states that "In the browser of this invention, the  
12 **hard disk** is used to cache the information available on the Web" (emphasis added, Hawes, col. 4,  
13 lines 10-11).

14 Moreover, Hawes disclosure and teachings are not related to inserting image data into  
15 a document containing text created with an application program on the same computer that is in  
16 communication with the image source device, as clarified in the amended claims. Hawes is  
17 directed to updating the display of Web pages that are downloaded from a remote server and  
18 rendered by a browser on the user's client computer. Hawes correctly specifies that "A browser is  
19 a computer program which enables a user to look at information on other computers and retrieve  
20 information from other computers in an environment that allows for cross-platform  
21 communications" (Hawes, col. 1, lines 58-62). Hawes does not disclose or suggest creating a Web  
22 page document with an application program on the user's client computer. Hawes also does not  
23 disclose or suggest that an image is obtained from an active image source device in communication  
24 with the user's client computer. Conversely, Sobol does not disclose or suggest Web pages, a  
25 browser, or any other aspect of Hawes that would motivate one of ordinary skill in the art to select  
26 and combine Sobol and Hawes.

27 The Examiner indicates that one of ordinary skill in the art would be motivated to combine  
28 Hawes with Sobol, because the Examiner believes that Hawes teaches efficient storage of images.  
29 However, Hawes does not disclose or suggest any storage efficiency that is of any use to Sobol.  
30 Sobol requires storage efficiency only in the form of data compression whereby image data are  
31 "compressed by a conventional data compression technique, such as run-length encoding" (Sobol,  
32 col. 4, lines 64-65). Sobol explains that "The method [ ] minimizes the amount of memory required  
33 to store the image data by compressing the image data before performing any image transformation  
34 processes (e.g., scaling and/or rotation)" (Sobol, col. 5, lines 6-9). However, Hawes discloses a  
35 technique for reducing the time required to transmit data from a remote device, not by reducing the

1 data size, but by eliminating the need to retransmit from the remote device, data that have not  
2 changed. Eliminating some retransmission of data does not compress the image data for more  
3 efficient transformation processes. Thus, one of ordinary skill in the art would not be motivated to  
4 select and combine Sobol and Hawes. Accordingly, the rejection under 35 U.S.C. § 103(a) of  
5 independent Claim 1 as amended should be withdrawn.

6 As to independent Claim 18, the Examiner appears to have misunderstood the claim language.  
7 The claim language is amended to clarify its meaning. The Examiner indicates that "Sobol fails to  
8 explicitly disclose: *insertion scheme for selecting a plurality of the stored multiple images for*  
9 *insertion into the document*" (italics in original, emphasis added, Office Action, page 4). The  
10 Examiner apparently refers to step (a) of Claim 18. However, step (a) recites an image source device  
11 user interface that provides a "selection" scheme, not an insertion scheme. Correspondingly, step (b)  
12 provides for enabling a user to select a plurality of images. Nevertheless, the Examiner  
13 misinterpreted step (a), and referred to the background section of Hawes as teaching "the selection  
14 and insertion of images into a web page" (Office Action, page 4). The cited background refers to  
15 generating a Web page with an editing language, such as hypertext markup language (HTML).  
16 Specifically, Hawes indicates that "HTML allows for the embedding of images, sounds, video  
17 streams, form fields and simple text formatting into a page" (Hawes, col. 1, lines 43-44). While an  
18 HTML editor will allow a user to embed such items into a page, Hawes does not disclose or suggest  
19 that an HTML editor comprises an image source device user interface running on a computer in  
20 communication with an image source device that stores image source data comprising multiple  
21 images, as the amended claim language now recites. Further, Hawes does not disclose or suggest that  
22 a browser enables an image source device user interface for *selecting* a plurality of the stored  
23 multiple images. The browser does NOT enable the user to select the images that will be *inserted*  
24 into the received Web page. Thus, Hawes does not provide the claim element that the Examiner  
25 admits is missing from Sobol. Accordingly, the rejection under 35 U.S.C. § 103(a) of independent  
26 Claim 18 as amended should be withdrawn.

27 With regard to independent Claim 24, the Examiner indicates that the claim is directed  
28 towards a system for implementing the steps found in Claim 1, and therefore rejects the claim on the  
29 same grounds as Claim 1. Applicants have amended Claim 24 in a manner corresponding to the  
30 amendment to Claim 1. In light of the amendments and remarks set forth above with regard to  
31 Claim 1, the rejection under 35 U.S.C. § 103(a) of independent Claim 24 as amended should be  
32 withdrawn.

33 Also, a dependent claim inherently includes all elements of the independent claim from which  
34 the dependent claim depends (MPEP § 608.01(n)). Thus, a dependent claim is patentable for at least  
35 the same reasons as its base independent claim. Therefore, the rejection of dependent

1 Claims 2-17, 19-23, and 25-33 should be withdrawn for the reasons noted above, in regard to  
2 independent Claims 1, 18, and 24, as amended. Moreover, in regard to Claims 3 and 6, the Examiner  
3 provides no indication that Sobol or Hawes discloses or suggests the additional elements of these two  
4 claims. Instead, the Examiner arbitrarily rejects these claims on the basis that they are directed  
5 towards a method for implementing the steps found in a previous claim. Because the Examiner has  
6 not provided any well reasoned justification for rejecting these claims, their rejection should be  
7 withdrawn.

8 Claims Rejected under 35 U.S.C. § 103(a) Over Sobol, Hawes, and Photoshop

9 Dependent Claims 7, 8, 19, 22, 25, and 31 have been rejected under 35 U.S.C. § 103(a)  
10 as being unpatentable over Sobol in view of Hawes, and further in view of "Mastering  
11 Photoshop 5 for the Web" (1998, pp. 1-10, hereinafter "Photoshop"). Applicants  
12 respectfully disagree that one of ordinary skill in the art would be motivated to consider the  
13 teaching of the Photoshop reference for any combination with Sobol. Sobol is directed to  
14 "the transformation of **grayscale** image data" (emphasis added, Sobol, col. 1, lines 6-7) in the  
15 form of line art drawings (See Sobol, col. 1, line 62 through col. 2, line 6). There is no reason to  
16 enable Sobol to perform any image enhancement, because Sobol specifically changes  
17 the grayscale image data to discrete black and white image data. Specifically, Sobol first  
18 reduces "the number of gray image pixels by 'punching to black' gray image pixels having  
19 intensity values less than a black punch value and by 'punching to white' gray image  
20 pixels having intensity values greater than a white punch value" (Sobol, col. 3,  
21 lines 21-26). Sobol explicitly states that "The grayscale image data produced by [a]  
22 high resolution re-scan are not changed or manipulated by the scanning utility 22, but fed  
23 directly to the image handler 18" (Sobol, col. 7, lines 51-54). The image handler  
24 performs the "punching" so that "all pixels having intensity values less than the black  
25 punch value 44 are assigned the intensity value corresponding to black (i.e., 0), whereas all  
26 pixels having intensity values greater than the white punch value 46 are assigned the  
27 intensity value corresponding to white (i.e., 255)" (Sobol, col. 7, line 65 through col. 8,  
28 line 3). If enhancements, such as contrast, brightness, or color level, were allowed, Sobol  
29 would not produce the proper "punched" image. Thus, Sobol teaches away from  
30 any combination with Photoshop that enables altering or enhancing an image. Accordingly, the  
31 rejection under 35 U.S.C. § 103(a) of dependent Claims 7, 8, 22, and 31 should be  
32 withdrawn. The rejection of Claim 11 over Sobol, Hawes, Photoshop, and further in view  
33 of "Troubleshooting and Configuring the Windows NT/95 Registry," Clayton Johnson  
34 (1997, pp. 1-2, hereinafter "Troubleshooting") should be withdrawn for the reasons above  
35 that one of ordinary skill would not be motivated to select and combine Photoshop with Sobol.

1 The rejection of dependent Claims 19, 25, and other dependent claims not  
2 specifically addressed should be withdrawn for the reasons stated above  
3 regarding the patentability of the independent claims from which the dependent claims ultimately  
4 depend.

5 Claims Rejected under 35 U.S.C. § 103(a) Over Sobol, Hawes, and ADF

6 Dependent Claims 12, 13, 15, and 17 have been rejected under 35 U.S.C. § 103(a)  
7 as being unpatentable over Sobol in view of Hawes, and further in view of "IBM ADF  
8 Color Scanner User's Guide" (7/1997, pp. 14-22 and figs. 1-16, hereinafter "ADF").  
9 Applicants respectfully disagree that the cited references teach or suggest all of the  
10 claim elements. The Examiner refers to a portion of the ADF reference that introduces a  
11 user interface function for enabling a user to define or change one of four predefined actions  
12 that can be performed by the color scanner. For each of the four actions, ADF explains  
13 how a user should complete a number of parameter fields for an input dialog box to create  
14 or change one of the predefined actions. For example, ADF explains that one of the  
15 steps necessary to define a copy action is to "Go to the Settings list box and select a copy type"  
16 (ADF, page 15). As another example, under the description for defining the Scan and  
17 Save action, ADF requires the user to "Verify or change the scan mode, brightness,  
18 contrast, resolution, disposition, and document type information on the SCAN & SAVE  
19 screen" (ADF, page 19). Because the user must select image capture parameters in this cited  
20 prior art, ADF does not disclose or suggest the element of Claim 12, recited as "determining  
21 whether the image source device that is active is able to perform an automatic image scan,  
22 wherein the automatic image scan comprises the steps of comprises the steps of capturing an  
23 image of a graphic source with said image source device and inserting the data representing the  
24 image into the document, **all without requiring a user to select image capture parameters.**"  
25 (Emphasis added.) Accordingly, the rejection under 35 U.S.C. § 103(a) of dependent Claim 12  
26 should be withdrawn. Because Claims 13, 15, and 17 depend from Claim 12, the rejection of  
27 Claims 13, 15, and 17 should be withdrawn for at least the same reasons as Claim 12. Also, as  
28 discussed above, the rejection of other dependent claims not specifically addressed should be  
29 withdrawn for the reasons above regarding the independent claims from which the dependent  
30 claims depend.

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1 In view of the preceding amendments and remarks, it will be apparent that all claims in this  
2 case currently define a novel and non-obvious invention, and that the application is in condition for  
3 allowance and should be passed to issue without further delay. Should any further questions remain,  
4 the Examiner is invited to telephone applicants' attorney at the number listed below.

5  
6 Respectfully submitted,

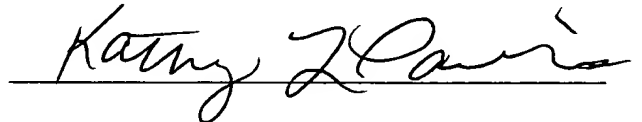
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10 Ronald M. Anderson  
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1 MARKED-UP VERSION OF THE AMENDMENTS

2 Amendment to the Specification

3 In the Specification:

4 Please amend the specification as follows:

5 On Page 4, the paragraph beginning at line 6 should be amended as shown below.

6 According to [a second] another aspect of the invention, the method allows the user to select  
7 the image acquisition device through a dialog that contains a drop-down menu control populated with  
8 a list of one or more image acquisition devices available to the user, thereby bypassing TWAIN's  
9 select source dialog, which is normally required when using TWAIN for acquiring images. The  
10 dialog also enables the user to select a predetermined resolution level, corresponding to whether the  
11 document is to be primarily viewed in printed form or as an online document (e.g., as a web page).

12 Amendment to the Claims

13 In the Claims:

14 Please amend Claims 1, 18, and 24 as follows:

15 1. (Amended) A method for inserting an image into a document, [having a text content  
16 produced by an application program, the application program executing on a computer in  
17 communication with at least one image source device, the method] comprising the steps of:

18 (a) making an image source device active, wherein the image source device is in  
19 communication with a computer executing an application program used to create a text content of  
20 said document;

21 (b) acquiring an image using the image source device that is active; and

22 (c) inserting data representing said image into said document so that the image  
23 appears in the document and comprises a portion of the document, all without saving said data in  
24 other than a temporary buffer.

25 18. (Amended) A method for inserting a plurality of images into a document, [having a text  
26 content that is produced with an application program, the application program running on a computer  
27 in communication with an image source device that stores image source data comprising multiple  
28 images, the method] comprising the steps of:

29 (a) enabling an image source device user interface [that] with an application  
30 program used to create a text content of the document and running on a computer in communication  
31 with an image source device that stores image source data comprising multiple images, wherein the  
32 image source device user interface provides a selection scheme for selecting a plurality of the stored  
33 multiple images for insertion into the document;

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1 (b) enabling a user to select a plurality of images to be inserted into the document;  
2 (c) transferring data representing the selected images from the image source  
3 device to the computer;  
4 (d) converting said data representing the selected image into a compressed format;  
5 and  
6 (e) inserting said compressed format image data into the document so that the  
7 document includes the plurality of images.

8 24. (Amended) A system for inserting an image into a document, [produced by an  
9 application program, the system] comprising:

10 (a) a computer having a memory and a processor, the memory storing machine  
11 instructions that are executable on the processor;

12 (b) an application program comprising machine instructions that are stored in the  
13 computer memory, said application program having been used to create the document;

14 (c) an image acquisition device connected in communication with the computer  
15 and providing image data representing an image;

16 (d) a source driver module comprising computer-executable instructions stored in  
17 the memory and in communication with the image acquisition device so as to control acquisition of  
18 an image from the image acquisition device;

19 (e) a source manager module comprising computer-executable instructions stored  
20 in the memory and in communication with the source driver module, the source manager module  
21 providing commands to the source driver module to acquire an image from the image acquisition  
22 device; and

23 (f) an interface module comprising computer-executable instructions stored in the  
24 memory and in communication with the source manager module and the application program, the  
25 interface module providing commands to the source manager to acquire an image from the image  
26 acquisition device, the data representing the image being inserted into the [application program]  
27 document.